

REMARKS

Claims 85 and 86 were pending in the present application. Claim 86 has been amended.

Double Patenting Rejections

In the September 9, 2004 office action, claims 85 and 86 were rejected under the judicially created doctrine of obviousness-type double patenting rejection based on a judicially created doctrine grounded in public policy, as being unpatentable over claim 1 of U.S. Patent No. 6,699,458.

Without acquiescing to the merits of this rejection, applicants ask that this issue be held in abeyance until the claims are otherwise deemed to be allowable. Applicants will then offer to file a terminal disclaimer to obviate these rejections if appropriate.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 85 and 86 have been rejected under 35 U.S.C. §112, second paragraph, as purportedly being indefinite.

Applicants respectfully submit that the term “thiol protecting group” in claim 85 is definite, because one of ordinary skill in the art would know the meaning of the term and the groups which this term is referring in claims 85 and 86. Namely, the term “thiol protecting group” refers to any chemical group or moiety that is used to protect the thiol (*i.e.*, sulfur) atom from participating in a reaction.

Additionally, the USPTO has granted a number of patents that have claims reciting the term “thiol protecting group.” *See, e.g.*, U.S. Patent No. 6,004,531 to Archer et al. at

claim 1, column 35, line 16; U.S. Patent No. 6,004,529 to Yu et al. at claim 1, column 12, line 18; U.S. Patent No. 6,667,389 to Dean et al. at claim 3, column 15, line 56; U.S. Patent No. 6,409,987 to Cardin et al. at claim 10, column 17, line 42. As evidenced from the claims allowed in these patents, it is evident that the USPTO has recognized that the term “thiol protecting group” has a definite and acceptable meaning under 35 U.S.C. § 112. Therefore, applicants respectfully submit that claims 85 and 86 fully comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph. Accordingly, applicants respectfully request that this rejection be withdrawn.

Claim 86 has also been rejected as purportedly ambiguous because of a missing period at the end of the claim. Applicants have amended claim 86 to include a period after the structure. Therefore, applicants respectfully submit that the rejection has been overcome, and respectfully request that it be withdrawn.

Objections to the Disclosure

The disclosure has been objected to because of markings on pages 3, 4 and 6 of the Specification. Accordingly, applicants are submitting in the present *Amendment and Response to Office Action* replacement sections for “Background of the Invention” and “Brief Description of the Invention” in accordance with 37 U.S.C. § 1.121(b)(2). All purported markings have been removed. No new matter has been added. Applicants therefore respectfully submit that this objection has been overcome, and therefore respectfully request that it be withdrawn.

Specification

As requested in the *Office Action*, applicants have updated the continuing data under the "Background of the Invention" heading, to reflect that the present application is a continuation in part of U.S. Application Serial No. 10/025,208, now U.S. Patent No. 6,699,458.

CONCLUSION

In light of the above amendments and remarks, applicants respectfully submit that the present application is in condition for allowance, early notice of which is earnestly sought. Should any outstanding issues remain, the Examiner is invited to call applicants' undersigned attorneys at the number listed below.

No fee is believed to be due for the filing of this *Amendment and Response to Office Action*. However, the Commissioner is hereby authorized to charge any fee(s) required or credit any overpayment to Deposit Account No. 50-0540.

Respectfully submitted,

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